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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,836	04/17/2004	Wade C. Horton	HORTON-PA-1	8772

7590
OBER / KALER
c/o Royal W. Craig
120 East Baltimore Street
Baltimore, MD 21202

EXAMINER

FIGUEROA, ADRIANA

ART UNIT	PAPER NUMBER
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3633

MAIL DATE	DELIVERY MODE
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12/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,836	Applicant(s) HORTON, WADE C.	
	Examiner ADRIANA FIGUEROA	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5,7 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-11,13,14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/17/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal brief filed on 09/10/2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/DAVID DUNN/

Supervisory Patent Examiner, Art Unit 3636

Election/Restrictions

2. An election/restriction requirement was presented on 05/02/2006 between species 1, Figures 1 and 2 and Species 2, Figures 3A-3C. However, after further

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consideration the election restriction requirement is deemed unnecessary, and therefore has been withdrawn. Accordingly, claims 1-4, 6, 8-11, 13 and 14 have been examined.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations: “the thin rigid sheet of material having an annular lip protruding rearwardly there from for insertion into, seating within and proper positioning with said cutout” and “a convex inner edge” recited in claim 1 and “the accent frame flares slightly away from the planar surface” recited in claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1, 4, 10, 11 and 13 are objected to because of the following informalities: claim 1 in line 2, the phrase "and having circular cutout" is incorrect, the correct phrase is "and having a circular cutout", in claims 4, 10, 11 and 13 in line 1, the phrase "said frame" should be "said accent frame". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. In claim 1, the limitation "a convex inner edge defining a circular aperture" does not have support in the original disclosure. Examiner would like to note that the specification in page 5, line 20 and page 9, line 6 discloses "the accent frame 5 may be

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formed with a slight convex curvature”, but does not disclose “the inner edge being convex”.

7. In claim 8, the limitations “wherein said article is an electrical box with a screw mounted outlet or switch plate and wherein said frame is secured in place between the structure and the outlet or switch plate” present a conflict with the limitation in claim 1 of “a recessed lighting fixture” since the switch plate can not be a recessed lighting fixture at the same time. Thus, the embodiment claimed in claim 8 was not disclosed in the original disclosure and is therefore not enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 8-11, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape” in lines 8-9 and “the flat two-dimensional object-shaped outer edge” in line 15. Examiner contends that “the object-shaped outer edge” has three dimensions, length, width and thickness. Only images would truly be two dimensional. Even a sheet of paper has some thickness and is three dimensional.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 6, 9, 10, 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239).

Regarding claim 1, as best understood, Bobrick discloses in combination with a ceiling (10) comprising a planar surface defined by opposing sides and having a circular cutout (c) there through, a recessed lighting fixture (l) mounted on one side of said planar surface over said cutout and conforming thereto, (annotated Fig 1), and a finishing ring (46) defined by an aperture conforming to said cutout, said finishing ring being mounted on another side of said planar surface around said cutout and attached to the recessed lighting fixture (l) for providing a transition from said planar surface to said recessed lighting fixture, (Fig 1, Fig 5), but does not disclose an accent frame comprising a rigid thin sheet of material said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape larger in diameter than a finishing ring, and a convex inner edge defining an circular aperture conforming to said cutout, and having an annular lip circumscribing said aperture and protruding rearwardly there from for insertion into, seating within, and proper positioning with said cutout, said accent frame being sandwiched between said finishing ring and planar surface and maintained in place there between by the pressure of said finishing ring being retained to said

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recessed lighting fixture; the flat two-dimensional object-shaped outer edge of said accent frame protruding beyond said finishing ring and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface.

However, Hill teaches an accent frame(10) comprising a rigid thin sheet of material said rigid thin sheet having an outer edge (e) defining "as best understood" a flat two-dimensional object-shape larger in diameter than a finishing ring (5), and an inner edge (c) defining an aperture conforming to a cutout, and having an annular lip (l) circumscribing said aperture; said accent frame (10) being sandwiched between said finishing ring (5) and a planar surface and maintained in place there between by the pressure of said finishing ring being retained to the switch plate, (Fig 4); the flat two-dimensional object-shaped outer edge (e) of said accent frame (10) protruding beyond said finishing ring (5) and serves as an aesthetically pleasing backdrop to said finishing ring, serving to cover up any imperfections in the finish or cut of the surrounding planar surface, (Fig 1, 2, 4). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the lighting fixture assembly of Bobrick to include an accent frame as taught by Hill in order to provide an ornamental appearance and to enhance the general appearance of the lighting fixture assembly.

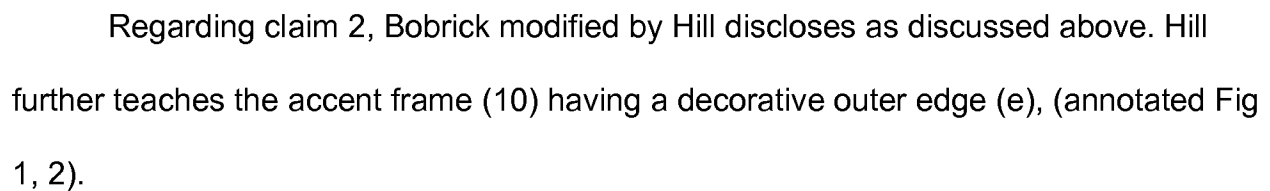
Examiner takes Official Notice that it is well known in the art to provide convex edges. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the inner edge of Hill to be convex

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in order to provide a smooth surface that would enhance the ornamental appearance of the frame instead of having a right angled edge. Further, convex edges provide for rounded corners that are smooth and more pleasing to the eye.

The annular protruding lip of Hill does not protrude rearwardly there from for insertion, seating within, and proper positioning with said cutout. However Bobrick teaches that it is well known in the art to have a protruding lip (48) that would allow for easier insertion of the element (46) into the cutout (Fig 2, 5). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the rigid thin sheet of material of Hill to include a protruding lip as taught by Bobrick in order to allow for easier insertion of the element into the cutout. Further, the examiner contends that it is known to those of ordinary skill in the art that the protruding lip would help to center the accent frame in place and prevent it from becoming off centered behind the finishing ring.

It would have been an obvious matter of design choice to modify the rigid thin sheet of material to have the convex inner edge defining a circular aperture, since such a modification would have involved a mere change in the shape of the component and would provide accent frames that can be used in the circular cutout of Bobrick. A change in shape is generally recognized as being within the level of ordinary skill in the art. Further, one would not try to place a rectangular accent frame into the round opening of Bobrick. Those of ordinary skill in the art know that round pegs go in round holes.



Regarding claim 6, Bobrick modified by Hill discloses as discussed above, but does not specifically teach that said thin sheet of material is approximately 1 mm thick. However, it would have been a matter of design choice to make the thin sheet approximately 1 mm thick, since such a modification would have involved a mere change in the size of the component and would provide a light weight sheet. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Regarding claim 9, Bobrick modified by Hill discloses as discussed in claim 1 Bobrick further teaches the planar surface being a ceiling (10), (Fig 1).

Regarding claim 10, Bobrick modified by Hill discloses as discussed in claim 1, but does not disclose said accent frame is constructed of a rigid material selected from the group consisting of wood, metal or plastic materials. However, it would have been a matter of design choice to construct the frame of wood, metal or plastic materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, all of the above materials would be obvious to use because they are all known to be easily shaped into a desired configuration.

Regarding claim 13, Bobrick modified by Hill discloses the basic claimed invention as discussed above. Hill further teaches the accent frame (10) is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finishing ring.

Regarding claim 14, Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose the object-shape is a closed form selected from the group consisting of a star, flower or a house. However, it would have been an obvious matter of design choice to modify the object of Bobrick and Hill to have a shape of a star, flower or a house, since such a modification would have involved a mere change in the shape of the component and would provide different decorative motives. A change in shape is generally recognized as being within the level

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of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Further, the examiner contends that the shape of the device does not constitute a patentable feature. The shape of the device is purely for decorative purposes.

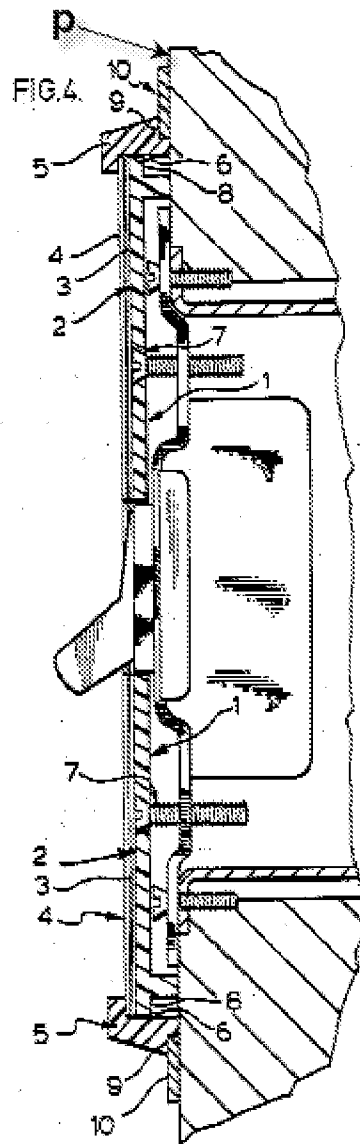
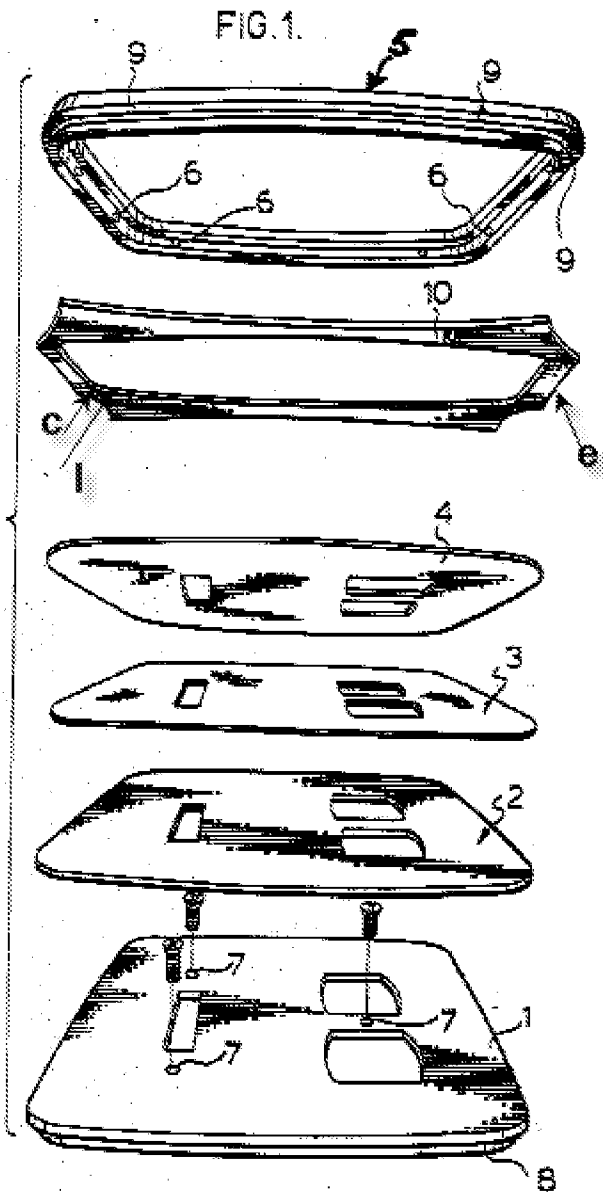
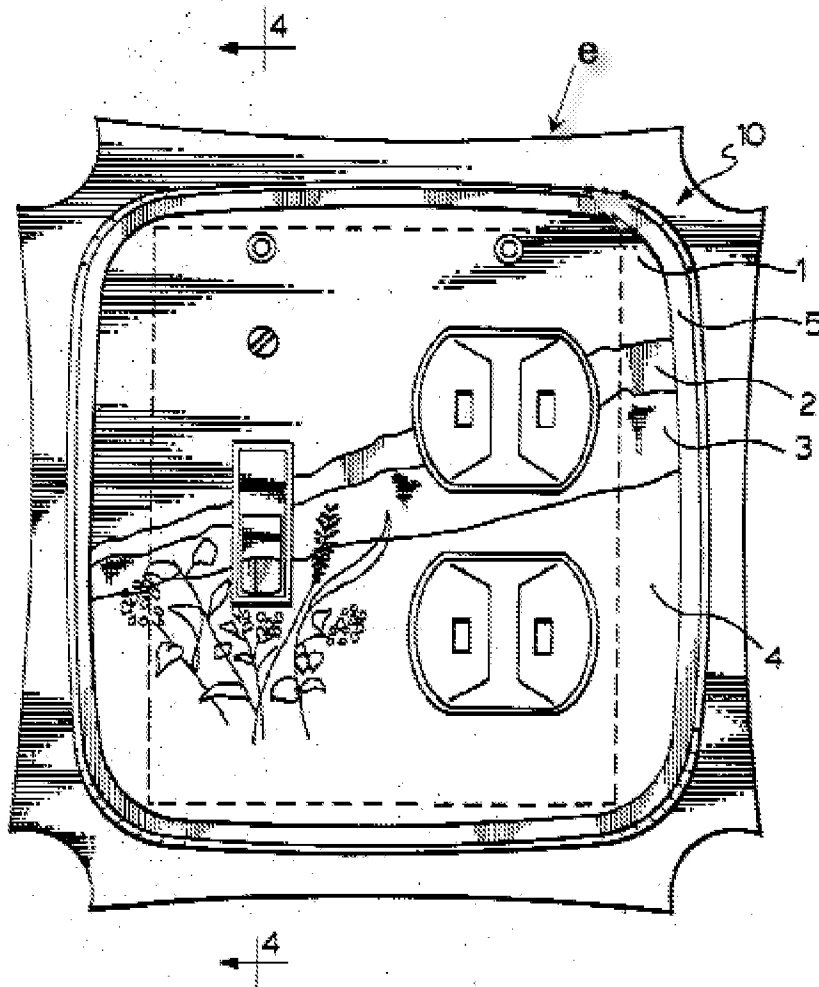


FIG. 2.



10. Claim 4, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Baldwin (US 6,281,440). Bobrick modified by Hill discloses the basic claimed invention as discussed above, but does not disclose that the accent frame flares slightly away from the planar surface to provide an aesthetically pleasing depth or texture to the frame. However, Baldwin teaches an accent frame (11) that flares slightly away from the planar surface (23), (Fig 1, 3). Therefore, it would have been obvious to a person having

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ordinary skill in the arts at the time of the applicant's invention to modify the accent frame of Bobrick and Hill to flare slightly away from the planar surface as taught by Baldwin in order to enhance the ornamental appearance of the frame.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick (US 3,697,742) in view of Hill (US 4,800,239) and further in view of Gretz (US 6,152,413). Bobrick modified by Hill discloses the basic claimed invention as discussed in claim 1, but does not disclose said accent frame is formed by injection molding. However, Gretz discloses a frame (10) formed by injection molding (Column 4, Lines 56-60). Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the frame of Bobrick and Hill to be formed by injection molding as taught by Gretz in order to provide a stronger and flexible frame. The examiner would also like to point out that the injection molding limitation is a process limitation. Therefore, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thus, even though Bobrick in view of Hill disclose the claimed invention, Gretz was further used to show that it is known to injection mold a frame.

Response to Arguments

12. Applicant's arguments with respect to claims 1 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Caferro (US D469, 916) and Lecluze (Des 387,466) teach accent frames having convex inner edges.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADRIANA FIGUEROA whose telephone number is (571)272-8281. The examiner can normally be reached on M-Th 7:30 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on (571)272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ADRIANA FIGUEROA/
Examiner, Art Unit 3633
12/03/2009

/Brian E. Glessner/
Primary Examiner, Art Unit 3633